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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,303	06/02/2005	Martin Meise	2923-703	2146

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ROTHWELL, FIGG, ERNST & MANBECK, P.C.
1425 K STREET, N.W.
SUITE 800
WASHINGTON, DC 20005

EXAMINER	
SAIDHA, TEKCHAND	

ART UNIT	PAPER NUMBER
1652	

NOTIFICATION DATE	DELIVERY MODE
06/13/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTO-PAT-Email@rfem.com

Office Action Summary	Application No.	Applicant(s)	
	10/537,303	MEISE ET AL.	
	Examiner	Art Unit	
	Tekchand Saidha	1652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 June 2005*.

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-37* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-37* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

2. This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

3. In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-15, drawn to a pharmaceutical composition comprising a Protein Tyrosine Phosphatase-1 (*PRL-1*) homologous protein or a nucleic acid molecule encoding *PRL-1* homologous protein. **Elect a single specific *PRL-1*** homologous protein **or** the corresponding encoding nucleic acid from Table 2.

Group II, claim(s) 16-17 & 28-29 drawn to **use** of *PRL-1* homologous protein **or** a nucleic acid molecule encoding *PRL-1* homologous protein for the manufacture of medicament for the treatment of obesity, diabetes, and/or metabolic syndrome.

Elect a single specific *PRL-1* homologous protein[1] **or** the encoding nucleic acid[2] **or** the modulator of nucleic acid molecule[3] **or** the modulator of said polypeptide[4] from Table 2.

Group III, claim(s) 18-19, drawn to non-human transgenic animal exhibiting a modified expression of a *PRL-1* homologous polypeptide according to claim 3. **Elect a single specific *PRL-1*** homologous protein[1] **as per Table 2.**

Group IV, claim(s) 20-21, drawn to a recombinant host cell exhibiting a modified expression of a *PRL-1* homologous polypeptide according to claim 3. **Elect a single specific *PRL-1*** homologous protein[1] **as per Table 2.**

Group V, claim(s) 22-23, 25-27, 34 & 36 drawn to a method of identifying a polypeptide involved in the regulation of energy homeostasis and/or metabolism of triglycerides in a mammal - based upon the binding properties of the polypeptides and identifying the polypeptides that bind to *PRL-1* homologous polypeptide according to claim 3. **Elect a single specific *PRL-1*** homologous protein[1] **as per Table 2.**

Group VI, claim(s) 24, 35 & 37, drawn to a method of screening for an agent, which modulates/effects the activity of *PRL-1* homologous polypeptide according to claim 3. **Elect a single specific *PRL-1*** homologous protein[1] **as per Table 2.**

Group VII, claim(s) 30-31, drawn to **use** of a vector or host cell of claim 7 or claim 20 for the manufacture of medicament for the treatment of obesity, diabetes, and/or metabolic syndrome, etc. **Elect a single** nucleic acid encoding **specific *PRL-1*** homologous protein[1] **as per Table 2,** comprised by the vector or host cell.

Group VIII, claim(s) 32, drawn to **use** of a nucleic acid encoding **specific *PRL-1*** homologous protein[1] **as per Table 2** for the production of non-human transgenic animal which over- or under-expresses specific *PRL-1* homologous protein.

Elect a single nucleic acid encoding **specific *PRL-1*** homologous protein[1] **as per Table 2.**

Group IX, claim(s) 33, drawn to a kit comprising at least one of (a).....thru.....(h). **Elect a single** nucleic acid or **specific *PRL-1*** homologous protein **as per Table 2,** for the kit.

4. The inventions listed as Groups I-IX do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical feature for the following reasons: The technical feature linking Groups I-IX appears to be that they all relate to Protein Tyrosine Phosphatase-1 (*PRL-1*). According to the international preliminary examination report [IPER] clams 1-15,17, 20-21, 23-24 & 33 lack novelty as being anticipated by WO 97/06262 A (2/20/1997) and claims 1-17, 20-21, 28, 30 & 33 lack novel novelty as being anticipated by WO 99/14340 A (3.25.1999). Therefore, Groups I-IX share no special technical feature as defined by PCT Rule 13.2, as it does not define a contribution over the prior art. Furthermore, the products (protein, DNA, transgenic animal or vector or host cell comprising the DNA) of Groups I, III, IV & IX do not share a special common structural or functional feature while, the methods of Groups II & V-VIII do not use the same reagents or produce the same results. In addition, the methods of Groups II & V-VIII do not comprise all of the methods for making or using the products of Groups I, III, IV & IX. Accordingly, Groups I-XI are not so linked by the same or a corresponding special technical feature as to form a single general inventive concept.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

6. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. Process claims that depend from or otherwise include all the limitations of the patentable product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

7. The listing of references in the Search Report is not considered to be an information disclosure statement (IDS) complying with 37 CFR 1.98. 37 CFR 1.98(a)(2) requires a legible copy of: (1) each foreign patent; (2) each publication or that portion which caused it to be listed; (3) for each cited pending U.S. application, the application specification including claims, and any drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion, unless the cited pending U.S. application is stored in the Image File Wrapper (IFW) system; and (4) all other information, or that portion which caused it to be listed. In addition, each IDS must include a list of all patents, publications, applications, or other information submitted for consideration by the Office (see 37 CFR 1.98(a)(1) and (b)), and MPEP § 609.04(a), subsection I.

states, "the list ... must be submitted on a separate paper." Therefore, the references cited in the Search Report have not been considered. Applicant is advised that the date of submission of any item of information or any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the IDS, including all "statement" requirements of 37 CFR 1.97(e). See MPEP § 609.05(a).

No copies of the references have been provided with the information disclosure statement filed 6/2/05.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tekchand Saidha whose telephone number is (571) 272 0940. The examiner can normally be reached on 8.30 am - 5.00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on (571) 272 0928. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Tekchand Saidha
Primary Examiner, Art Unit 1652
Recombinant Enzymes, E02A65 Remsen Bld.
400 Dulany Street, Alexandria, VA
Telephone: (571) 272-0940
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